UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/726,952</td><td>Applicant(s)
SCHOENBERG, ROY</td></tr>
<tr><td>Examiner
Rebecca L. Pachura</td><td>Art Unit
2136</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 December 2003</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-28 and 30-36</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-28 and 30-36</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>03 December 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>02/09/2004</u>.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   **Claims 1-28 and 30-36 are presented for examination.**

> The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on 02/09/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Change of Power of Attorney

3.   The change of Power of Attorney mailed on 11/21/2006 is duly noted.

Claim Objections

4.   Claim 29 is objected to because of the following informalities: Claim 29 is missing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.   **Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 30 recites the limitation "the processor" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 1-4, 6-10, 13-15, 17-28, 30, 31, 33, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6941271 (Soong).**

As to claim 1, Soong discloses a key maintenance method comprising: maintaining, in a datastore, a first-level access key that grants, to a medical service provider, a level of access to a set of medical records of a patient (Soong column 2, lines 47-57); retrieving the first-level access key; and generating a second-level access key by modifying the level of access of the first-level access key (Soong column 11, lines 6-49).

As to claim 2, Soong discloses the key maintenance method of claim 1 wherein: the levels of access of the first-level and second-level access keys are defined using one or more access parameters; the set of medical records is a multi-portion medical record; and the access parameters provide access to one or more portions of the set of medical records (Soong column 12, lines 16-34).

As to claim 3, Soong discloses the key maintenance method of claim 1 further comprising transmitting the second-level access key to the medical service provider, wherein the medical service provider subsequently stores the second-level access key on an MSP key repository assigned to the medical service provider (Soong column 6, lines 32-49).

As to claim 4, Soong discloses the key maintenance method of claim 1 further comprising storing the second-level access key in the datastore (Soong column 11, lines 6-49).

As to claim 6, Soong discloses the key maintenance method of claim 4 wherein the datastore is a patient key repository assigned to the patient (Soong column 11, lines 16-27).

As to claim 7, Soong discloses the key maintenance method of claim 6 wherein the first-level access key was previously-provided to the medical service provider and previously-stored on an MSP key repository assigned to the medical service provider (Soong column 6, lines 32-49).

As to claim 8, Soong discloses the key maintenance method of claim 7 wherein: the patient key repository is a first portion of a centralized key repository; and the MSP key repository is a second portion of the centralized key repository (Soong column 5, lines 14-36).

As to claim 9, Soong discloses the key maintenance method of claim 8 wherein the centralized key repository resides on and is executed by a remote server connected to a distributed computing network (Soong column 5, lines 9-11).

As to claim 10, Soong discloses the key maintenance method of claim 9 wherein: the remote server is a web server; and the distributed computing network is the Internet (Soong column 5, lines 39-42).

As to claim 13, Soong discloses the key maintenance method of claim 1 wherein the second-level access key enhances the level of access of the first level access key, wherein the medical service provider is granted a greater level of access to the set of medical records of the patient (Soong column 11, lines 39-44).

As to claim 14, Soong discloses the key maintenance method of claim 1 wherein the second-level access key reduces the level of access of the first level access key, wherein the medical service provider is granted a reduced level of access to the set of medical records of the patient (Soong column 11, lines 30-39).

As to claim 15, Soong discloses the key maintenance method of claim 1 wherein the second-level access key revokes the level of access of the first level access key, wherein the medical service provider is prohibited from accessing the set of medical records of the patient (Soong column 11, lines 44-49).

As to claim 17, Soong discloses the key maintenance method of claim 16 wherein the datastore is a patient key repository assigned to the patient (Soong column 11, lines 16-27).

As to claim 18, Soong discloses the key maintenance method of claim 17 wherein the first-level access key was previously-provided to the medical service provider and previously-

stored on an MSP key repository assigned to the medical service provider (Soong column 6, lines
32-49).

As to claim 19, Soong discloses the key maintenance method of claim 18 wherein: the
patient key repository is a first portion of a centralized key repository; and the MSP key
repository is a second portion of the centralized key repository (Soong column 5, lines 14-36).

As to claim 20, The key maintenance method of claim 19 wherein the centralized key
repository resides on and is executed by a remote server connected to a distributed computing
network (Soong column 5, lines 9-11).

As to claim 21, The key maintenance method of claim 20 wherein: the remote server is a
web server; and the distributed computing network is the Internet (Soong column 5, lines 39-42).

As to claim 22, A key maintenance system comprising: a server system including a
computer processor and associated memory, the server system having a centralized key
repository and a centralized medical record repository (Soong column 5, lines 7-9); wherein the
server system is configured to: maintain, in a datastore, a first-level access key that grants, to a
medical service provider, a level of access to a set of medical records of a patient (Soong column
2, lines 47-57); retrieve the first-level access key; and generate a second-level access key by
modifying the level of access of the first-level access key (Soong column 11, lines 6-49).

As to claim 23, The key maintenance system of claim 22 wherein the server system is
further configured to store the second-level access key in the datastore (Soong column 11, lines
6-49).

As to claim 24, The key maintenance system of claim 23 wherein the datastore is a
patient key repository assigned to the patient (Soong column 11, lines 16-27).

As to claim 25, Soong discloses the key maintenance system of claim 24 wherein the first-level access key was previously-provided to the medical service provider and previously-stored on an MSP key repository assigned to the medical service provider (Soong column 6, lines 32-49).

As to claim 26, Soong discloses the key maintenance system of claim 25 wherein: the patient key repository is a first portion of a centralized key repository; and the MSP key repository is a second portion of the centralized key repository (Soong column 5, lines 14-36).

As to claim 27, The key maintenance system of claim 26 wherein the centralized key repository resides on and is executed by a remote server connected to a distributed computing network (Soong column 5, lines 9-11).

As to claim 28, The key maintenance system of claim 27 wherein: the remote server is a web server; and the distributed computing network is the Internet (Soong column 5, lines 39-42).

As to claim 30, A computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by the processor, cause that processor to: maintain, in a datastore, a first-level access key that grants, to a medical service provider, a level of access to a set of medical records of a patient (Soong column 2, lines 47-57); retrieve the first-level access key; and generate a second-level access key by modifying the level of access of the first-level access key (Soong column 11, lines 6-49).

As to claim 31, The computer program product of claim 30 further comprising instructions for storing the second-level access key in the datastore (Soong column 11, lines 6-49).

As to claim 33, The computer program product of claim 30 wherein the datastore is a

patient key repository assigned to the patient (Soong column 11, lines 16-27).

As to claim 34, Soong discloses the computer program product of claim 33 wherein the

first-level access key was previously-provided to the medical service provider and previously-

stored on an MSP key repository assigned to the medical service provider (Soong column 6, lines

32-49).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claims 5, 11, 12, 16, 32, 35, and 36 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over US 6941271 (Soong) in view of US 20040068650 (Resnitzky).

As to claim 5, Soong discloses the key maintenance method of claim 4. Soong fails to

teach further comprising deleting the first-level access key from the datastore.

However, Resnitzky discloses further comprising deleting the first-level access key from

the datastore (Resnitzky page 7, paragraph 0128).

It would be obvious to one of ordinary skill in the art at the time of the applicant's

invention to combine Soong and Resnitzky because Soong teaches multiple databases and

Resnitzky teaches manipulating databases (Resnitzky page 7, paragraph 0128).

As to claim 11, Soong discloses the key maintenance method of claim 7. Soong fails to teach further comprising reconciling the patient key repository and the MSP key repository.

However, Resnitzky discloses further comprising reconciling the patient key repository and the MSP key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

As to claim 12, Soong discloses the key maintenance method of claim 11. Soong fails to teach wherein reconciling includes overwriting the first-level access key stored within the MSP key repository with the second-level access key stored in the patient key repository.

However, Resnitzky discloses wherein reconciling includes overwriting the first-level access key stored within the MSP key repository with the second-level access key stored in the patient key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

As to claim 16, Soong discloses a key maintenance method comprising: maintaining, in a datastore, a first-level access key that grants, to a medical service provider, a level of access to a set of medical records of a patient (Soong column 2, lines 47-57); retrieving the first-level access key; generating a second-level access key by modifying the level of access of the first-level access key (Soong column 11, lines 6-49); and. Soong fails to teach deleting the first-level access key from the datastore.

However, Resnitzky discloses deleting the first-level access key from the datastore (Resnitzky page 7, paragraph 0128).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches manipulating databases (Resnitzky page 7, paragraph 0128).

As to claim 32, Soong discloses the computer program product of claim 30. Soong fails to teach further comprising instructions for deleting the first-level access key from the datastore.

However, Resnitzky discloses further comprising instructions for deleting the first-level access key from the datastore (Resnitzky page 7, paragraph 0128).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches manipulating databases (Resnitzky page 7, paragraph 0128).

As to claim 35, Soong discloses the computer program product of claim 34. Soong fails to teach further comprising instructions for reconciling the patient key repository and the MSP key repository.

However, Resnitzky discloses further comprising instructions for reconciling the patient key repository and the MSP key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's invention to combine Soong and Resnitzky because Soong teaches multiple databases and Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

As to claim 36, Soong discloses the computer program product of claim 35. Soong fails to teach wherein the instructions for reconciling include instructions for overwriting the first-

level access key stored within the MSP key repository with the second-level access key stored in
the patient key repository.

However, Resnitzky discloses wherein the instructions for reconciling includes
overwriting the first-level access key stored within the MSP key repository with the second-level
access key stored in the patient key repository (Resnitzky page 8, paragraphs 0130-0132).

It would be obvious to one of ordinary skill in the art at the time of the applicant's
invention to combine Soong and Resnitzky because Soong teaches multiple databases and
Resnitzky teaches how to reconcile them (Resnitzky page 8, paragraphs 0130-0132).

Prior Art

8.   The prior art made of record and not relied upon is considered pertinent to applicant's
disclosure. US 6006228 is pertinent because it teaches… The system includes a server (12A) in
which a number of documents are stored for access by user terminals (20A...20N). A database
(A) is provided in the server (12A) that has a device for storing user information, a device for
storing document information and a device for providing access to the stored documents
document-by-document on the basis of the user information and the document information. The
device for storing user information includes device for storing a user identification name, an
associated user password and an associated security level indicator for indicating the highest
level of security access with which the user name is associated.   US 20020180771 is pertinent
because it teaches… A virtual being database (154) made up of a set of hierarchically-arranged
fields, wherein each field is tagged with access control information (152) controlling which
parties (or computers) (110, 112, 114 and 116) are allowed to access each field, and which

parties (or computers) (110, 112, 114 and 116) are allowed to revise each field. Some fields of

the virtual being relate to personality traits (162), while other fields relate to body measurements.

Also, data requests to be made by a plurality of virtual beings (154) to a remote networked

computer (102) are aggregated into a single request in order to improve communication

efficiency. US 20060288425 is pertinent because it teaches… The method for securing data on a

personal computer having security sensitive content grouped into security levels, each with a

clearance code, includes filtering and extracting sensitive content by security level and separately

storing the security content in remote extract stores. Remainder data is stored locally or remotely.

A map for selected extract stores may be generated. The filter and/or map may be destroyed or

stored. The data input, extracted data and remainder data may be deleted from the originating

computer. Encryption may be utilized to enhance security (including transfers of data, filter and

map). Reconstruction of the data is permitted only in the presence of a predetermined security

clearance. Full or partial reconstruction is possible, based upon the security clearances. A

computer readable medium containing programming instructions and an information processing

system is encompassed. US 5530854 is pertinent because it teaches… A key is generated by the

database which uniquely identifies data in a child tuple. As a result, virtual parent relations are

referenced by an original primary key, but has its underlying attribute values stored in one or

more secondary relations whose access is gained through stored generated keys. The application

interface is unaffected, because the system transparently pieces together the virtual relation from

the primary and one or more secondary relations. US 7272230 is pertinent because it teaches…

To provide a cryptographic system capable of flexibly changing decryption authorization and

preventing the action of a third person impersonating a user having the decryption authorization

to improperly utilize the system. When an enciphered file is accepted in a client, a decryptor ID,

a creator ID, and a first enciphered session key are transmitted to a key management server 10

(step 141). It is judged whether or not the creator ID is stored as a decryption object ID in a

management database in correspondence with the decryptor ID (step 147). When the creator ID

is stored, the first enciphered session key is deciphered with an inherent key corresponding to the

creator ID in the management database (step 148), and the obtained session key is enciphered

with a public key corresponding to the decryptor ID (step 149). A secret key is used in a client

which has received a second enciphered session key so that deciphering processing is performed,

to obtain a session key. Enciphered data is deciphered with the session key. US 7353532 is

pertinent because it teaches… The invention includes various systems, architectures, frameworks

and methodologies that can securely enforce a privacy policy. A method is include for securely

guaranteeing a privacy policy between two enterprises, comprising: creating a message at a first

enterprise, wherein the message includes a request for data concerning a third party and a privacy

policy of the first enterprise; signing and certifying the message that the first enterprise has a

tamper-proof system with a privacy rules engine and that the privacy policy of the first entity

will be enforced by the privacy rules engine of the first enterprise; sending the message to a

second enterprise; and running a privacy rules engine at the second enterprise to compare the

privacy policy of the first enterprise with a set of privacy rules for the third party.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Rebecca L. Pachura whose telephone number is (571) 270-3402.

The examiner can normally be reached on Monday-Thursday 10:00 am-8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nasser Moazzami can be reached on (571) 272-4195. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rebecca L Pachura/
Examiner, Art Unit 2136

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136